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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/358,937	07/23/1999	ALLAN C. SPRADLING	PM 254812	2149

7500 03/06/2002  
Pillsbury Winthrop LLP  
Intellectual Property Group  
1600 Tysons Boulevard  
McLean, VA 22102

EXAMINER

WOITACH, JOSEPH T

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 03/06/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**Application No.  
**09/358,937**Applicant(s)  
**Spradling, A.C. et al.**Examiner  
**Joseph T. Voitach**Art Unit  
**1632**

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Feb 19, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: See attached.

4. ☐ Applicant's reply has overcome the following rejection(s):  
\_\_\_\_\_
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See attached.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):  
Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: \_\_\_\_\_  
Claim(s) rejected: 1, 2, 4-10, 16, 18, 23-31, 33, 35, and 36
9. The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s) Deborah Crouch
11. Other: \_\_\_\_\_

**DEBORAH CROUCH**  
**PRIMARY EXAMINER**  
**GROUP 1800/1630**

Art Unit: 1632

Section 3(a):

The recitation of 'increases the abundance of' is a new embodiment different in scope and nature from 'maintains more' which was not previously considered, and would require a new search and further consideration. It is also noted that in this amendment, the preamble of the claim for maintaining would not be accomplished, rather the method would result in an increased number of stem cells. Further, the claims raise new 112, second paragraph issues regarding the expression of the nucleic acid because it is not clear what cells or where the expression occurs. Claim 25 now recites a 'second' and it is unclear if the second host contains the necessary elements to affect the method of claim 1.

Section 6(c):

With regards to Applicants' request for reconsideration of the withdrawal of claims 12, 13 and 17, it is noted that in the election of species, Applicants elected the species 4(c)(i) transduction with a nucleic acid encoding DPP (see paper number 11, page 1). In light of Applicants' election of an invention, claims 12 and 13 were interpreted to encompass stimulating a pathway by the BMP receptor, which is group 4(c)(iv), and claim 17 was interpreted to encompass 4(c)(i) and (ii) as set forth in the restriction requirement (see paper 10; pages 4-5).

The remaining arguments are directed to claim amendments which have not been entered, however, Applicants arguments have been fully considered. With respect to arguments

Art Unit: 1632

presented for the 35 USC 112, second paragraph, rejections, it is noted that the proposed claim amendments appear to obviate the basis of the rejections, however the amendments have not been entered. With respect to arguments regarding 35 USC 102 and 103 rejections, Examiner would agree that the discovery that the expression of Dpp which results in an increased number of stem cells in Drosophila was an unexpected observation, however the specific type or amount of expression of Dpp which results in the specific and unexpected outcome is not set forth in the claims. Absent the specific embodiments recited in the claims which differentiate the instant invention from the methods taught in the art, the claims would be anticipated or obvious for the reasons set forth in the previous office actions.